

REMARKS

Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

The Examiner has repeated the rejection of claim 14 stating that the phrase "said adjacent rolled roofing membranes" lacks antecedent basis. With this amendment, Applicant has amended claim 14 per the Examiner's suggest with respect to claim 1.

The Examiner has repeated the rejection of claim 2 stating that the phrase, "generally opposite" does not definitely recite the structural relationship between the parting agent covered surface area, the substrate and the clean surface area. Applicant respectfully traverses this conclusion.

The term "generally" does not render a claim indefinite per se. MPEP § 2173.05(b) states, in relevant part,

The fact that claim language includes terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph. ...Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Applicant respectfully submits that the language used in claim 2

is readily understandable by one of ordinary skill in the art, especially when read in view of the specification. As MPEP § 2173.02 states, "The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available."

Claims 13 and 15 have been objected to due to language informalities. With this amendment, Applicant has corrected these informalities.

Claims 1-9 and 11-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennepohl et al. (hereinafter referred to as "Kennepohl") in view of Simpson et al. (hereinafter referred to as "Simpson") and in further view of McGroarty et al. (hereinafter referred to as "McGroarty"). Applicant respectfully traverses this rejection.

Applicant respectfully submits that McGroarty does not disclose or suggest, "a decorative surface area and a clean surface area on said upper surface of said substrate" as recited in independent claim 1 and 14, as explained hereinbelow. With this amendment, Applicant has amended independent claims 1 and 14

to further clarify that the lower surface of the substrate of the present invention is disposed proximate the support surface to which it is intended to be installed onto.

In rejecting the pending claims, the Examiner suggests modifying Kennepohl to include the edge portion 13 disclosed in McGroarty, and suggests that the edge portion 13 reads on the "clean surface area" recited above in independent claims 1 and 14.

Applicant respectfully submits, however, that the edge portion 13 disclosed in McGroarty is not disposed on the top surface as claimed in independent claims 1 and 14, but rather is disposed on the bottom surface.

Applicant respectfully submits that McGroarty discloses a composite waterproofing sheet product 12 including a layer of high-density polyethylene (HDPE) 10 arranged on the top surface (i.e., the surface which is exposed to the elements when installed). (See, for example, column 5, lines 4-7, "It should be noted that the composite waterproofing sheets are installed with the water impervious membrane [10] facing outwardly to the elements.") As such, the edge portion 13 is not disposed on the top surface as claimed in independent claims 1 and 14, but rather is disposed on the bottom surface of the layer of HDPE

10. Accordingly, Applicant respectfully submits that the rejection of the pending claims in view of the combination of Kennepohl, Simpson, and McGroarty is improper because these references does not disclose or suggest all of the elements of the present invention, in their proper arrangement, either individually or in combination.

Applicant further submits that McGroarty teaches away from forming the edge region 14 anywhere but on the bottom surface of the HDPE layer 10, and that it would be improper to modify or interpret McGroarty as suggesting forming the edge region 14 anywhere but on the bottom surface of the HDPE layer 10. The edge region 14 disclosed in McGroarty is formed by leaving the edge portions 13 of the HDPE layer 10 free of the layers of bentonite 11. See column 4, lines 61-68 ("In manufacture, an edge portion 13 of the membrane or sheet 10 may be left without the layer 11 of particles, as shown in FIG. 2"). Accordingly, McGroarty explicitly teaches away from forming the edge region 14 anywhere but on the bottom surface of the HDPE layer 10.

Moreover, modifying McGroarty to include the bentonite layer 11 on the top surface of the HDPE layer 10 would render McGroarty's invention unsuitable for its intended purpose and

would change the principle of its operation in violation of MPEP § 2143.01.

McGroarty specifically discloses that the purpose of the invention is to provide a water impervious membrane. To this end, McGroarty states,

The water impervious membrane [10] provides a primary line of waterproofing, and if, for example, the membrane gets pierced, the water penetrates into the bentonite layer [11] and the bentonite [11] will expand into the ruptured membrane [10] opening to form a seal. Water soluble dyes can be added to or incorporated into the bentonite [11] to assist in the identification of the area of a leak because as water enters the bentonite [11], the dye will dissolve and the leaking water will then stain the leak area to make it visible, even after the problem areas have been back filled or covered. (Column 2, line 62-Column 3, line 4.)

Again, the present invention permits identifying the source of damage to the membrane, and the bentonite layer provides for self-sealing immediately. (Column 3, lines 36-38.)

If McGroarty was modified to include the bentonite layer 11 on the upper (i.e., outer surface) such that the bentonite layer 11 was exposed to the elements, then the "self-sealing" properties of the bentonite layer 11 would be rendered useless. Moreover, the water soluble dye would be rendered useless. See also, column 10, lines 29-38 ("This feature [i.e., the use of colored dyes to indicate leaks) could not be used if the membrane were not

impermeable to the passage of water."). Accordingly, modifying McGroarty to include the bentonite layer 11 on the upper surface (and hence the edge portion 14) would render McGroarty unsuitable for its intended purpose and would further change the principle of its operation in violation of MPEP § 2143.01.

For at least the reasons discussed above, Applicant submits that the rejection of the pending claims in view of the combination of Kennepohl, Simpson, and McGroarty is improper and should be withdrawn.

The Examiner is invited to telephone the undersigned, Applicant's Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

Thomas Zickell

By



Paul J. Kroon, Jr., Esq.
Registration No. 51,902
Attorney for Applicant
BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104
Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date: Dec. 3, 2004